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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,457	08/25/1999	MARTIN RUSSELL HARRIS	P06477USO/DE	5254

881 7590 02/05/2003

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ALEXANDRIA, VA 22314

EXAMINER
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ROBINSON, MARK A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/382,457

Applicant(s)

HARRIS, MARTIN RUSSELL

Examiner

Mark A. Robinson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 42-62 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 13-17, 19-23, 42, 43 and 45-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9-12, 18, 24-26 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/02 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,9,10,18,24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Penkethman made of record.

Penkethman shows in figs. 2 and 3 an optical apparatus including a laser light source (note col. 4 line 41)

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illuminating a fiber tip(210b), beam splitter (215--note that this lens acts to separate the two beams), and light receiving means(220b,230) near the light source, wherein return light is deviated by a small angle relative to 90 degrees from the incident light. Note that these elements may be said to form a "head."

The method limitations of claims 24-26 are inherent in the structure shown by Penkethman.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11,12 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penkethman.

Regarding claims 11 and 12, Penkethman shows the incident and return beams to be substantially parallel and coaxial with their respective beams before impinging upon the beam splitter in a similar manner as found in applicant's arrangement, but

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does not show the beam splitter to include a plurality of lenses of prisms. However, beam splitters including either prisms or multiple lenses are well known in the art. Use of such in Penkethman's device would have been obvious to the ordinarily skilled artisan at the time of invention as an art-recognized functionally equivalent means for providing separation of the two beams.

Penkethman shows the limitations of claim 44 as discussed above, but does specifically teach the returning light to be broader than the incident light. However, use of known illumination which would enable a broader return beam (either spatially or spectrally) would have been obvious to the ordinarily skilled artisan at the time of invention depending upon the type of imaging to be performed upon the specimen.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached at (703) 308-1687. The fax phone number for the

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organization where this application or proceeding is assigned is  
(703) 308-7722.

Any inquiry of a general nature or relating to the status  
of this application or proceeding should be directed to the  
receptionist whose telephone number is (703) 308-0956.

MR

1/29/03

  
MARK A. ROBINSON  
PRIMARY EXAMINER